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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,063	08/23/2001	Michael R. Dupelle	04644-101001	1672

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EXAMINER

MULLEN, KRISTEN DROESCH

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/938,063

Applicant(s)

DUPELLE ET AL.

Examiner

Kristen Mullen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-14, 17, 21 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-14, 17, 21 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12-14, 17, 21 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gliner et al. (6,178,357) in view of Ferrari (5,571,165) and further in view of Smith Ind. Pub. Lim. Co., (EPO 434258 A2).

Regarding claim 26, Gliner shows a pair of electrode pads (20) a non-electrode area (center of pad assembly) positioned between the two electrodes and mechanically connected to the two electrodes (20); text or other indicia (52) on the electrode pad assembly; an electrical cable (16); an adhesive area at each electrode; the adhesive area at each electrode being separated from the adhesive area at the other electrode by an area without adhesive (Col. 4, lines 32-36; Col. 5, lines 10-14; Col. 5, lines 59-65); and at least one release sheet (42) covering each adhesive area (Col. 4, lines 1-36; Col. 5, lines 10-14; Col. 5, lines 59-65).

Although Gliner fails to specifically point out that the electrode pads have a skin contacting area of at least 50 centimeters squared, attention is directed to Ferrari which teaches that the ANSI/AAMI (American National Standards Institute/ Association for the Advancement of Medical Instrumentation) specifies the minimum active area of individual self adhesive electrodes used for adult defibrillation should be at least 50 centimeters squared (Col. 1, lines 19-28). Therefore, it would have been obvious to one with ordinary skill in the art at the time the

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invention was made to size the defibrillation electrodes of Gliner to have an active area of at least 50 square centimeters in order to comply with industry standards for the minimum active area of individual defibrillation electrodes.

Although Gliner and Ferrari fail to show each release sheet being folded in a substantially U-shaped configuration and each sheet having a tab sized and configured to be grasped by one hand of the user; and each release sheet being configured to be removed by the user by pulling on the tab; attention is directed to Smith Ind. Pub. Lim. Co., which shows an adhesive pad with a release sheet having this configuration (Figs. 1-4). Smith Ind. teaches this release sheet configuration provides a means to avoid adhesive contact with the fingers so that the adhesive will not become contaminated or lose effectiveness (Col. 4, lines 29-32, Col. 1, lines 17-20, lines 24-33). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the electrode pad of Gliner and Ferrari with a release sheet having the configuration of Smith Ind. in order to avoid adhesive contact with the fingers so that the adhesive will not become contaminated and lose effectiveness.

The recitation regarding user actions are statements of intended use and have been carefully considered but have been deemed not to impart any further structural limitations over the prior art.

With respect to claim 12, Gliner shows the electrode pad assembly further comprises a conductive gel (32) at the skin contacting area of each electrode (20).

Regarding claims 13-14, Ferrari further shows that it is known for the adhesive area of a defibrillation electrode to comprise a non-conductive adhesive (29 mounted on 28) that surrounds a conductive gel (25).

Regarding claim 17, Gliner shows the defibrillator comprises an automatic external defibrillator.

With respect to claim 21, Smith Ind. shows the release sheets are configured so that as the release sheets are peeled away, a fold about which the release sheet is folded travels in the direction in which the second portion is pulled (Fig. 3).

### *Response to Arguments*

3. Applicant's arguments filed 6/27/05 have been fully considered but they are not persuasive.

In response to applicant's assertion that Gliner does not express a preference for a non-adhesive area separating the adhesive areas of the electrodes, the examiner disagrees. A declared preference for one element over the other is not necessary for there to be a teaching of either element. All that is required is that the element be disclosed.

In response to applicant's assertion that Gliner does not suggest associating a different release liner with each electrode, the examiner disagrees. On the contrary Gliner shows one or more pieces of release tape (42). See Figs. 4B and 5A.

In response to applicant's assertion that the Gliner teaches away from the concept of aligning an electrode assembly before removing the release liner, the examiner asserts that such intended use does not further modify the structural elements of the claim.

In response to applicant's arguments that release liners in wound dressings and defibrillator electrodes with release liners are not analogous, the examiner disagrees. Two criteria have been used by our reviewing courts to determine whether prior art is analogous: whether the art is from the same field of endeavor, and if the reference is not in the same field of

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endeavor, whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 599 F.2d 1032 (C.C.P.A., 1979), *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir., 1986), *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir., 2004). Even if the examiner conceded that Gliner and Smith Ind. are not from the same field of endeavor, the Gliner and Smith Ind. references are reasonably pertinent to the particular problem with which the inventor was involved and thus meet the second prong of the analysis. Applicants sought to cover the adhesive electrode portions of an electrode assembly with release sheets. The Gliner and Smith Ind. references both disclose covering adhesives with release sheets. Due to the fact that applicants' apparatus includes adhesives and release sheets, the adhesives and release sheets of Gliner and Smith Ind. are both reasonably pertinent to applicants' invention. "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Clay*, F.2d 656, 659 (Fed. Cir., 1992).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristen Mullen whose telephone number is (571) 272-4944. The examiner can normally be reached on M-F, 10:30 am-6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Kristen Mullen*

  
Robert E. Pezzuto  
Supervisory Patent Examiner  
Art Unit 3762

kdm